

Handwritten signature/initials.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,836	12/21/2000	Edward O. Clapper	42390P10784	8616

21906 7590 12/04/2002

TROP PRUNER & HU, PC  
8554 KATY FREEWAY  
SUITE 100  
HOUSTON, TX 77024

EXAMINER

TIEU, BINH KIEN

ART UNIT	PAPER NUMBER
----------	--------------

2643

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



## Office Action Summary

Application No.

09/745,836

Applicant(s)

CLAPPER, EDWARD O.

Examiner

BINH K. TIEU

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 28, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hazra et al. (U.S. Pat. #: 5,787,154 as cited in the previous Office Action) in view of Tasaki et al. (U.S. Pat. #: 4,879,744).

Regarding claims 28, 29 and 31, Hazra et al. ("Hazra") teaches an apparatus, such as an universal authentication (AU) device, and a method for use in making a communication from a first communication device such as calling telephone terminal (i.e., caller telephone terminal such as payphone or his/her own telephone) to a second communication device such as authentication system including a network switch/PBX or a gatekeeper coupled to a communication network, as shown in figure 6 (col.8, lines 5-25). The AU device comprises a memory having recorded therein, a substantially unique identifying value for use in authenticating usage of the AU device (i.e., PIN for a limited number of times and a limited amount of time). The memory of AU device also has a preprogrammed custom ID message (i.e., sequence id of the AU device) for delivery to the second communication device (authentication system) upon authenticated usage of the apparatus; and provides a preprogrammed custom ID message for delivery to the second communication device upon authenticated usage of the

Art Unit: 2643

apparatus (i.e., the sequence id of the AU device imbedded in an encoded 16-digits output to be transmitted to the authentication system, col.7, lines 16-63).

It should be noticed that Hazra fails to clearly teach the respective telephone number to be stored in the memory at a time later than the manufacturing of a calling card as argued by Applicant in his remarks filed on 10/21/2002. However, Tasaki et al. ("Tasaki") teaches such features in col.1, line 48 – col.2, line 5 for a purpose of saving time and of providing convenience to calling card by automatic dialing the stored telephone number after the first use.

Therefore, it would have been obvious to one of ordinary skill in the art at time the invention was made to incorporate the use of such features, as taught by Tasaki above, in view of Hazra, in order to save time and to provide convenience when the calling card is in use.

3. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hazra et al. (U.S. Pat. #: 5,787,154) in view of Tasaki et al. (U.S. Pat. #: 4,879,744) as applied to claim 28 above, and further in view of Longo et al. (U.S. Pat. #: 5,912,956 also cited in the previous Office Action).

Regarding claim 27, Hazra and Tasaki, in combination, teaches all subject matters as claimed above, except for a feature of providing a plurality of preprogrammed custom ID messages on said apparatus. However, Longo et al. ("Longo") teaches an identification tag as shown in figure 3 comprising a plurality of preprogrammed custom ID messages for finder or caller to select (col.4, lines 1-44) for a purpose of reaching the respective destination terminal.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of providing a plurality of preprogrammed custom

Art Unit: 2643

ID messages on said identification tag, as taught by Longo, in view of Hazra and Tasaki in order to improve on the manner of making calls for specific request service(s) from the AU device.

***Response to Arguments***

1. Applicant's cancellation with respect to claims 12-18 and 21-27 were noted. Applicant's argument with respect to new claims 28-31 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

**Any response to this final action should be mailed to:**

**Box AF**

**Commissioner of Patents and Trademarks  
Washington, D.C. 20231**

**Or faxed to:**

**(703) 872-9314 (for formal communications; please mark**

**"EXPEDITED PROCEDURE")**

**Or:**

**If it is an informal or draft communication, please label  
"PROPOSED" or "DRAFT")**

**Customer Service (703) 306-0377**

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (703) 305-3963 and E-mail address: BINH.TIEU@USPTO.GOV.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

Art Unit: 2643

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Or faxed to:

(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist, tel. No. 703-305-4700).

A handwritten signature in black ink, appearing to read 'Binh Tieu', followed by a long horizontal line.

**BINH TIEU**  
**PRIMARY EXAMINER**

Art Unit 2643

Date: December 02, 2002